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PTO/SB/97 (09-04)

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Attorney Docket No. 47004.000056

Application Serial No. 09/552,879

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APPLICATION NO.: 09/552,879

ATTY. DOCKET NO. 47004.000056
CORRESPONDENCE: MAY 1, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application Of:

John CARNAHAN *et al.*

Application Number: 09/552,879

Filed: April 20, 2000

For: SYSTEM AND METHOD FOR DYNAMIC, MULTIVARIABLE
COMPARISON OF FINANCIAL PRODUCTS)
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)
)
)
)

Group Art Unit: 3628

Examiner: Siegfried E. Chencinski

Confirmation No.: 5010

MAY 01 2006

MAIL STOP AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450CORRESPONDENCE

Sir:

REQUEST TO CORRECT FINALITY OF OFFICE ACTION

The Supplemental Office Action dated April 7, 2006 (the "Supplemental Action") once again improperly finally rejects the claims of this application. In the previous Office Action dated February 3, 2006 (the "First Final Action"), the Examiner rejected the claims based on new grounds of rejection and stated that such new grounds were "required by applicant's amendments to independent claims 21 and 28." See Office Action, p. 5 ("Response to Arguments" section). However, as the Examiner admits in the Supplemental Action, the Applicants did not make any claim amendments in the preceding reply — rather, the Examiner inadvertently used the wrong form paragraph in rejecting the claims. See Supplemental Action at 2. However, even though the Examiner admits that there were no amendments to the claims requiring the new grounds of rejection, the Examiner still maintains the finality of the rejection in the Supplemental Action.

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According to MPEP § 706.07(a), making the rejection final under these circumstances is **clearly not proper**:

Under the present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)...

MPEP § 706.07(a) (emphasis added). In the present case, the Examiner presented a new grounds of rejection that was not necessitated by the applicant's amendment (none were made), and was not based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. § 1.97(c).

Furthermore, by maintaining the finality of the rejection, the Examiner is clearly denying the Applicant the opportunity to respond to the new grounds of rejection before being forced to appeal the rejection or file a Request for Continued Examination.

For this reason, the Applicants respectfully request withdrawal of the Final Office Action, and issuance of a new, properly-issued **non-final** Office Action.

REQUEST FOR CLARIFICATION OF GROUNDS OF REJECTION

The Supplemental Action also includes several inconsistencies that make the Supplemental Action ambiguous and/or incomprehensible, and clarification of these inconsistencies is respectfully requested in order to allow the Applicant a full and fair opportunity to address the rejections.

First, the Supplemental Action lists all of the claim rejections under the heading of "Claim Rejections - 35 USC § 103." Supplemental Action at 2. Consistent with this, in the first rejection, the Examiner rejects claims 21 and 28 over Wallman (6,601,044) using a Section 103 obviousness rationale: "it would have been **obvious** that a first set of investment funds etc. is taught to be presented to the investor in Wallman." Supplemental Action at 3-4 (emphasis added). Despite this reliance upon an obviousness rejection, the Examiner lists this rejection as being anticipation under 35 U.S.C. § 102(e): "Claims 21-23, 27-30 and 34 are rejected under 35

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U.S.C. 102(e) as being anticipated by Wallman." Supplemental Action at 3. In view of this inconsistency, clarification of the exact nature of the rejection is requested and necessary for the Applicant to proceed.

Second, the Supplemental Action alleges that the patent application "contains no such clear definition for the phrase 'user defined level of importance.'" Supplemental Action at 7. In support, the Office Action sets forth a discussion based on the unrelated terms "the user's purchase history," and "item selection histories," and concludes that "[t]hose skilled in the art would recognize that maintaining a processed reduction of 'item selection histories', as links table 301 docs, reads on maintaining item selection histories." *Id.* This part of the Supplemental Action has nothing to do with the terms or claims of the present application, and appears to have been inserted from an unrelated patent application. Clarification of this part of the Office Action is also required.

Respectfully submitted,
HUNTON & WILLIAMS LLP

Dated: May 1, 2006

By: 

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